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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,342	05/23/2001	Geoffrey D. Alexander	RSW9-2001-0094-US1	1143

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EXAMINER

HAQ, NAEEM U

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,342

Applicant(s)

ALEXANDER, GEOFFREY D.

Examiner

Naeem Haq

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This action is in response to the Applicant's amendment filed on November 8, 2004. Claims 1-37 are pending and will be considered for examination. The amendments to claims 1 and 14 are sufficient to overcome the rejection under 35 U.S.C. 112, second paragraph given in the last Office Action. This rejection is hereby withdrawn.

Final Rejection

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 6, 7, 14, 19, 20, 27, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman et al. (US 5,960,411).

Referring to claim 1, 6, 7, 14, 19, 20, 27, 32, and 33, Hartman teaches a method, system and computer program for providing online comparison shopping by a website system accessible by a user through a communication network, the method comprising the steps of: compiling a shopping list identifying specific items to be purchased (Figure 1C, items '106' and '107'); optimizing, by the website system, the shopping list to produce an optimal shopping order (column 5, lines 27-55). Hartman does not teach receiving optimization criteria specified by the user. However, Hartman teaches

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providing a user with a "shipping method" (Figure 1C, item '108'). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to allow the user to select a different shipping method such as express mail or overnight mail in the method, system and program of Hartman. One of ordinary skill in the art would have been motivated to do so in order to allow the user to speed up delivery of the product. Hartman does not teach that the optimizing is based on the optimization criteria specified by the user. However, Hartman teaches optimizing based on shipping. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to perform the optimization based on the user-specified shipping method. One of ordinary skill in the art would have been motivated to do so in order to be more responsive to the needs of the customer. Hartman does not teach two or more vendors. However, the Examiner notes that this limitation appears in the preamble only. Furthermore, the body of the claim does not depend on this limitation for completeness. *"A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone."* See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

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Claims 2, 3, 4, 5, 10-13, 15-18, 23-26, 28-31, and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman et al. (US 5,960,411) in view of Official Notice.

Referring to claims 2, 4, 5, 13, 15, 17, 18, 26, 28, 30, 31, and 37, Hartman teaches the limitations of claims 1, 6, 7, 14, 19, 20, 27, 32, and 33 as noted above. Hartman does not teach receiving the user's modifications to the optimal shopping order; re-optimizing the shopping list based on the modifications to produce an updated optimal shopping order; and displaying the updated optimal shopping order to the user. However, Official Notice is taken that it is old and well known in the art to receive the user's modifications to the optimal shopping order; re-optimizing the shopping list based on the modifications to produce an updated optimal shopping order; and displaying the updated optimal shopping order to the user. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the method, system and program of Hartman. One of ordinary skill in the art would have been motivated to do so in order to allow a user to develop various "what if" scenarios from which to choose the most favorable.

Referring to claims 3, 16, and 29, Hartman teaches the limitations of claims 1, 14 and 27 as noted above. Hartman does not teach receiving an acceptance of the optimal shopping order from the user; and processing the optimal shopping order in response to the receipt of the acceptance from the user. However, Official Notice is taken that it is old and well known in the art to process an order based on receiving an acceptance of the optimal shopping order from the user; and processing the optimal

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shopping order in response to the receipt of the acceptance from the user. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature in the invention of Hartman. One of ordinary skill in the art would have been motivated to do so in order to be more responsive to a customer.

Referring to claims 10 and 23, Hartman teaches the limitations of claims 1 and 14 as noted above. Hartman does not teach that the optimizing step is performed off-line; or notifying the user with a notification message when the off-line optimizing step is completed. However, Official Notice is taken that it is old and well known in the art to perform processing off-line and to provide a notification message when the processing is completed. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate these features into the invention of Hartman. One of ordinary skill in the art would have been motivated to do so in order to avoid excessive on-line charges.

Referring to claims 11 and 24, Hartman teaches the limitations of claims 1 and 14 as noted above. Hartman does not teach that the notification message is communicated to the user using e-mail. However, Official Notice is taken that it is old and well known in the art to use email notification messages. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate email notifications into the invention of Hartman. One of ordinary skill in the art would have been motivated to do so in order to use a well-known and widely available communication tool for sending notifications.

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Referring to claims 12 and 25, Hartman teaches the limitations of claims 1 and 14 as noted above. Hartman does not teach that the notification message includes a unique identifier to be used by the user to access the optimal shopping order through the website system. However, the use of a URL as a unique identifier that is used by a user to access a shopping order through a website system is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate an embedded URL link in a notification message in the invention of Hartman. One of ordinary skill in the art would have been motivated to do so in order to allow a user to access information by clicking on a link rather than by typing a long URL.

Referring to claims 35 and 36, Hartman teaches the limitations of claim 27 as noted above. Hartman does not teach notifying the user when its shopping order optimization process fails, or repeating shopping order optimization process until an optimal shopping order is produced, and notifying the user when the optimization process produces the optimal shopping order. However, Official Notice is taken that it is old and well known in the art for a program to provide error recovery in the event the program fails to process data properly. The error recovery typically notifies a user when a process fails, repeats the process, and notifies the user when the processing is successful. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the invention of Hartman. One of ordinary skill in the art would have been motivated to do so in order to provide a user-friendly way of handling processing failure.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive. The Applicant has argued that the limitation "two or more vendors" patentably distinguishes the claimed invention from the prior art. The Examiner respectfully disagrees. As noted above, this limitation is recited in the preamble only. *"A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone."* See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Since the Applicants have failed to seasonably challenge the Examiner's Official Notice presented in the previous Office Actions, the Examiner now interprets all Official Notices as admitted prior art. *Applicant must seasonably challenge well known statements and statements based on personal knowledge when they are made. In re Selmi*, 156 F.2d 96, 70 USPQ 197 (CCPA 1946). *If Applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). Also see MPEP 2144.03.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on (703)-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naeem Haq, Patent Examiner
Art Unit 3625

February 3, 2005



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